No. 87-11

Supreme Court, U.S.
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In The Supreme Court of the United States

October Term, 1987

MOR-FLO INDUSTRIES, INC., AND AMERICAN APPLIANCE MFG. CORP.,
Petitioners,

vs.

STATE INDUSTRIES, INC.,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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REPLY BRIEF

Respondent does not dispute that there are inconsistent rulings of law by the Court of Appeals for the Federal Circuit; previously, as in the present case, that "reduction to practice" *is* a prerequisite for purposes of "on sale" preclusion, while more recently in *UMC Corporation v. United States*, 816 F.2d 647 (Fed. Cir. 1987),[1] that "reduction to practice" *is not* a prerequisite.

Respondent purports to find reason for disinterest of the Court in this important principle of the patent law

[1] UMC's suggestion for rehearing *en banc* was declined on July 14, 1987.

because inconsistent and diverse holdings of the Federal Circuit are not expressly enumerated as basis for the issuance of the writ in Supreme Court Rule 17. Respondent's view ignores the fact that the Federal Circuit is endowed with exclusive jurisdiction over patent appeals and that Rule 17 clearly contemplates resolution of such conflicts and restoration of uniformity and reliability in the law. Further, amendments to Rule 17 expressly provide that "the same general considerations outlined above will control in respect of petitions for writs of certiorari to review judgments of the United States Court of Appeals for the Federal Circuit. . . ."

Respondent's argument that the district court in the instant case decided the "on sale" defense on two "separate and independent reasons", i.e. no reduction to practice and that the invention was not disclosed in the offer for sale, is also of no moment. These "reasons" are neither separate nor independent. As Petitioner previously noted (Petition p. 4), the *UMC* court held that without a reduction to practice, what is offered for sale cannot disclose the invention, *UMC*, 816 F.2d at 651-52, consequently the district court's holding that the invention was not disclosed in the offer made, is not an independent basis for the Court's decision on the "on sale" defense.

Respectfully submitted,

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